

REMARKS

Claims 63-68 are the pending claims in the present application. Applicants cancel, without prejudice, claims 1-62. Applicants add new claims 69-75. Support for the subject matter of these claims is found throughout the specification. No new matter has been entered. Applicants respectfully request reconsideration in view of the following remarks. Issues raised by the Examiner will be addressed below in the order they appear in the prior Office Action.

1. Claims 63 and 68 are rejected under 35 U.S.C. 102 (a) as allegedly being anticipated by Ingham et al. Applicants traverse this rejection and contend that the rejection is moot in light of the amended claims.

As previously discussed in detail, Ingham et al. fail to satisfy the criteria for anticipating Applicants' invention. Both the MPEP and the Federal Circuit support Applicants' contention that in order to anticipate or render obvious the claimed invention, the cited art must teach all the limitations of the claimed subject matter (MPEP 2131). "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegall Bros. v. Union Oil Company of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ3d 1913, 1920 (Fed. Cir. 1989). The Ingham et al. application fails to teach the particular combination of elements of the pending claims.

Applicants contend that the relationship between the pending claims and the cited art is largely analogous to the factual situation in the above example. Applicants assert that the presently claimed invention is a species which is patentable over the generic teachings of Ingham et al.

Applicants maintain that Ingham et al. fail to satisfy the criteria necessary for anticipating Applicants' invention. Nevertheless, to expedite prosecution of claims directed to commercially relevant subject matter, Applicants have amended the claims to more particularly point out certain embodiments of the invention. Applicants' amendments are not in acquiescence of the rejection, and Applicants reserve the right to prosecute claims of similar or differing scope. Reconsideration and withdrawal of this rejection are respectfully requested.

2. Claims 63 and 65-68 are rejected under 35 U.S.C. 103(a) as allegedly being obvious in view of Ingham et al. Applicants traverse this rejection and contend that the rejection is moot in light of the amended claims.

As preciously discussed, Applicants maintain that the claimed subject matter is not obvious in view of the teachings of Ingham et al. Applicants contend that a valid patent may issue for a nonobvious species related to a prior patented invention, even though the improvement falls within the claims of that prior patent. A prior genus which does not explicitly disclose a species **does not** anticipate a later claim to that species. This position is well supported by the holdings of the Federal Circuit. See, for example, *Corning Glass Works v. Sumitomo Electric U.S.A.*, 868 F.2d 1251, 1262, 9 USPQ2d 1962, 1970 (Fed. Cir. 1989).

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Applicants maintain that the presently claimed invention is not obvious in view of Ingham et al. Nevertheless, to expedite prosecution of claims directed to commercially relevant subject matter, Applicants have amended the claims to more particularly point out certain embodiments of the invention. Applicants' amendments are not in acquiescence of the rejection, and Applicants reserve the right to prosecute claims of similar or differing scope. Reconsideration and withdrawal of this rejection are respectfully requested.

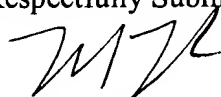
CONCLUSION

In view of the foregoing amendments and remarks, Applicants submit that the pending claims are in condition for allowance. Early and favorable reconsideration is respectfully solicited. The Examiner may address any questions raised by this submission to the undersigned at 617-951-7000. Should an extension of time be required, Applicants hereby petition for same and request that the extension fee and any other fee required for timely consideration of this submission be charged to **Deposit Account No. 18-1945**.

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Respectfully Submitted,



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